

Serial No. 10/770,893  
67097-022

Claims 1-5, 7, 8, 10-16, and 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Higashi. In response to Applicant's previous argument, the Examiner argues that Higashi's composition having up to 10wt% of the rare earth elements is close enough to the claimed composition having greater than 10wt% of rare earth elements that one of ordinary skill in the art would have expected these ranges to have the same properties. Respectfully, Applicant disagrees with this conclusion because there is no reasoning given to support that one of ordinary skill in the art would consider these ranges to be close approximations or have the same properties. For this reason, the rejection does not establish *prima facie* obviousness and Applicant respectfully requests that the rejection be withdrawn.

Additionally, Higashi teaches away from using an amount greater than 10wt%. Thus, Higashi itself provides evidence against obviousness by teaching that the composition should not exceed 10wt% of the rare earth elements (col. 2, lines 46-47). Thus, one of ordinary skill in the art would not modify the composition of Higashi to include more than 10wt% of the rare earth elements. For this additional reason, Applicant respectfully requests that the rejection be withdrawn.

Claims 1-3, 7-12, 15, 16, 26, and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over EP 570911. The Examiner admits that EP 570911 does not disclose a composition having the claimed minor alloy elements. However, the Examiner concludes that the minor alloy elements are inherent in the prior art. Respectfully, Applicant disagrees because the Examiner has not established that the claimed alloy elements are inevitably included in the composition of EP 570911. To support an inherency argument, the Examiner must show more than a probability or mere possibility, i.e., the Examiner must show that the claimed alloy elements are always or inevitably included in the composition. The Examiner is speculating, without any evidentiary basis, that the alloy elements would necessarily be included in the composition of EP 570911. Therefore, the burden remains with the Examiner to provide an evidentiary basis to support the assertion that these alloy elements are always included in the composition of EP 570911. For this reason, Applicant respectfully requests that the rejection be withdrawn.

Regarding the rejection of claims 1-6, 10-14, and 26-29 under 35 U.S.C. §103(a) as being unpatentable over Olson, Applicant has filed herewith a Declaration Under CFR 1.131 that establishes invention prior to the effective date of Olson in accordance with the Examiner's

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comments in the subject office action. Respectfully, Applicant submits that the Declaration is effective to overcome the Olson reference, and Applicant respectfully requests that the rejection be withdrawn.

Applicant believes that no additional fees are necessary, however, the Commissioner is authorized to charge Deposit Account No. 21-0279 in the name of United Technologies Corporation for any additional fees or credit the account for any overpayment.

Respectfully submitted,




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CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, fax number (571) 273-8300, on November 7, 2007.

  
Laura Combs